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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,332	09/17/2003	Peter Hamilton	10121/01705	5439
7590 02/18/2009 FAY KAPLUN & MARCIN, LLP Suite 702 150 Broadway New York, NY 10038				
EXAMINER RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
02/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,332

Applicant(s)

HAMILTON, PETER

Examiner

Anu Ramana

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneebaum et al. (US 5,423,830) in view of Cohen (US 5,336,252).

Schneebaum et al. disclose a method of grasping a selected portion of tissue from a surface of body cavity including: inserting an insertion device 60 into the body cavity; advancing a flexible cup 78 distally from a lumen of the insertion device; visually positioning the flexible cup adjacent a polyp or "selected portion of tissue" by using a fiber optic illumination guide and fiber optic image guide; and applying a vacuum to move the tissue from outside the cup to inside the cup (Figs. 5A-5C and col. 6, lines 5-55).

Schneebaum et al. also disclose fastening portions of tissue around a periphery of the polyp using a snare followed by severing the polyp from the surrounding tissue.

Schneebaum et al. disclose all elements of the claimed invention except for the cup being made of a transparent material.

Cohen teaches a suction cup made of a transparent material so that underlying tissue can be viewed through the cup (col. 11, lines 18-21).

Therefore, it would have been recognized by one of ordinary skill in the art at the time the invention was made that applying the known technique of molding a suction cup from a transparent material, as taught by Cohen, to the Schneebaum et al. device would have yielded predictable results, i.e., a suction cup that enables viewing of underlying tissue.

The method steps of claims 36 and 37 are performed when the attending surgeon, positions the flexible cup of the combination of Schneebaum et al. and Cohen adjacent tissue that must be removed.

Claims 35, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneebaum et al. (US 5,423,830) and Cohen (US 5,336,252), further in view of Wilk et al. (US 5,578,031).

The combination of Schneebaum et al. and Cohen discloses all elements of the claimed invention except for stapling to secure tissue.

It is well known that a surgical operation may include other steps such as stapling, as evidenced by Wilk et al. (col. 4, lines 8-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized an additional step such as a well known surgical technique for securing tissue such as stapling, to enable joining of severed tissue in the vicinity of the polyp being removed.

The method steps of claims 35, 38 and 39 are rendered obvious by the above discussion.

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on December 12, 2008 have been considered.

Applicant's arguments with respect to the rejections under 35 USC 103(a) over Schneebaum et al. and Cohen are not persuasive for the following reasons.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Schneebaum et al. disclose the use of a fiber optic illumination guide to "visually position a flexible cup adjacent a tissue." Since the flexible cup of the combination of Schneebaum et al. and Cohen is transparent, endoscopic visualization through the transparent cup is possible to the same extent as Applicant's invention.

Schneebaum et al. also disclose the use of a snare to grab and sever tissue.

Therefore, it is the Examiner's position that the combination of Schneebaum et al. and Cohen, renders obvious Applicant's claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
February 6, 2009

/Anu Ramana/
Primary Examiner, Art Unit 3775